Supreme Court, U.S.
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In The

Supreme Court of the United States

October Term, 1997

TRINITY INDUSTRIES, INC.,

Petitioner,

v.

JOHNSTOWN AMERICA CORPORATION AND JAC PATENT CORPORATION,

Respondents.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

1. Where a federal appellate court reverses a judgment with which the appellee was satisfied prior to reversal, does the appellee waive the right to seek remand on an issue affected by the reversal by failing to file a conditional cross appeal?

PARTIES TO THE PROCEEDINGS

The following are parties in this case:

1. Trinity Industries, Inc. – Trinity Industries, Inc. has no parent company and no nonwholly owned subsidiaries.

2. JAC Patent Corporation – JAC Patent Corporation is a wholly owned subsidiary of party Johnstown America Corporation.

3. Johnstown America Corporation – Johnstown America Corporation is a wholly owned subsidiary of Johnstown America Industries, Inc.

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PETITION FOR A WRIT OF CERTIORARI

Trinity Industries, Inc. ("Trinity") respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The Summary Judgment opinion of the district court (App. 9 – 32) is reported at 865 F. Supp. 1159 (W.D. Pa. 1994). The opinions of the Court of Appeals for the Federal Circuit on the merits (App. 1 – 8) and on Trinity's Petition for rehearing (App. 35 – 40) are unpublished.

STATEMENT OF JURISDICTION

Petitioner Trinity seeks review of the judgment of the Court of Appeals for the Federal Circuit entered May 28, 1997, and the denial of Trinity's timely petition for rehearing entered July 30, 1997. The Court of Appeals for the Federal Circuit had jurisdiction pursuant to 28 U.S.C. § 1295, which gives that court exclusive jurisdiction over appeals in patent cases. This Court has jurisdiction to review the judgment and denial of petition by the Court of Appeals for the Federal Circuit pursuant to 28 U.S.C. § 1254(1).

STATEMENT OF THE CASE

This is a patent case. Plaintiffs Johnstown American Corporation and JAC Patent Corporation (collectively "JAC"), licensee and owner of United States Patent No. 4,361,097 (the " '097 patent") respe[illegible]ely, sued Trinity claiming that its Aluminator II railway car infringed every claim in the '097 patent. The '097 patent contains just two independent claims, which are set forth below.[1]

The '097 patent claims a railway car floor structure comprised of two longitudinal troughs on either side of and extending below a longitudinal structural member referred to as a center sill. A key limitation present in all claims of the '097 patent is the requirement that the

---

[1] Claim 1 provides as follows:

> 1. A railway car for carrying bulk materials having a pair of side walls and a pair of end walls supported by spaced trucks, the improvement comprising a floor structure having
>
> (a) a center sill extending longitudinally over said trucks,
>
> (b) a pair of concave floor panels between said trucks, each panel forming a longitudinal curvilinear trough having closed ends, the longitudinal axis of each of said troughs extending parallel to the longitudinal axis of said center sill.

Claim 6 provides as follows:

> 6. A floor for a railway car comprising a center sill and a pair of longitudinal curvilinear troughs having closed ends secured to opposite sides of said center sill with the longitudinal axes of said troughs extending parallel to the longitudinal axis of said center sill.

longitudinal axes of the troughs must be parallel to the longitudinal axis of the center sill.

The parallelism limitation was added after the United States Patent & Trademark Office ("PTO") rejected all claims in the original patent application under 35 U.S.C. §§ 102, 103 based wholly or in part upon a 1922 patent, United States Patent No. 1,412,660 (the " '660 prior art patent"). The '660 prior art patent disclosed a railway car floor structure comprised of longitudinal troughs on either side of and below the longitudinal center sill structural member, but whose troughs were angled rather than being horizontal or parallel to the rail.

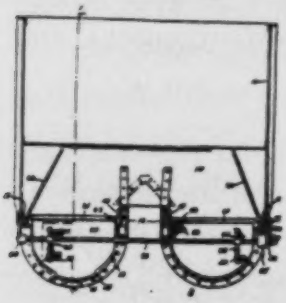

Fig. 2, '660 prior art patent.

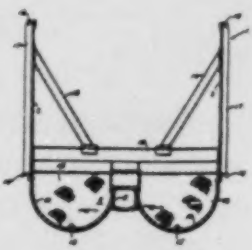

Fig. 3, '097 patent.

Here are copies of figures from the '097 patent and the '660 prior art patent.

The Trinity engineers who designed the Aluminator II sought to create a railway car that was different from and better than the railway cars that came before it. The troughs of the Aluminator II, like the troughs of the '660 prior art car, are not horizontal or parallel to the rail. Instead, they are pitched at a significant angle, which creates a number of benefits over horizontal troughs, including enhanced drainage, which facilitates efficient unloading and avoids coal hang-up during the discharge

process. The PTO ultimately granted three patents covering the floor structure of the Aluminator II. United States Patent Nos. 5,178,074; 5,341,747; Des. 344,913.

Proceedings Below

JAC sued Trinity for patent infringement on December 11, 1992, in the United States District Court for the Western District of Pennsylvania, Johnstown Division. The district court had jurisdiction pursuant to 28 U.S.C. § 1338, which grants exclusive jurisdiction to federal courts in patent cases. Trinity denied infringement, denied that the '097 patent was valid, and counterclaimed for a declaratory judgment of noninfringement and invalidity.

On September 13, 1993, Trinity moved for summary judgment of noninfringement based upon the absence in its Aluminator II railway car of a single element present in all claims of the '097 patent, the element requiring that the longitudinal axis of the troughs must be parallel to the longitudinal axis of the center sill. On September 2, 1994, the district court issued its opinion on Trinity's motion for summary judgment of noninfringement. (APP. 9-32) The district court interpreted the meaning of the parallelism limitation in all claims of the '097 patent as a matter of law, as would later be required by this Court's decision in *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996). Based upon that claim construction, the district court found that because the troughs of the Aluminator II were angled, the longitudinal axes of those troughs were not parallel to the longitudinal axis of the center sill. (APP. 17-21) Therefore, the court determined

that there was no literal infringement as a matter of law. The district court found that JAC's claim of infringement under the doctrine of equivalents presented fact issues that required resolution by a jury. (APP. 21-25) The district court's decision is reported at 865 F. Supp. 1159 (W.D. Pa. 1994).

The case was tried to a jury in July and August, 1996. Trinity challenged the validity of the '097 patent based on the '660 prior art patent, a prior art railway car made by Pullman (which was not before the PTO examiner who issued the '097 patent), and other prior art. In its charge, the district court instructed the jury on its construction of the parallelism limitation in the '097 patent, in effect advising the jury that the claimed invention was limited to troughs that were horizontal or parallel to the rail. Accordingly, the jury made its decisions about infringement and validity in light of that claim construction.

After a three week trial, the jury found that the Aluminator II did not infringe the '097 patent under the doctrine of equivalents and that Trinity had not shown the '097 patent to be invalid by clear and convincing evidence. The judgment of the district court on the jury verdict stated, "IT IS ORDERED AND ADJUDGED That judgment be entered in favor of the defendant, Trinity Industries, Inc. Judgment is hereby entered in accordance with the above verdict." (APP. 33)

JAC appealed to the United States Court of Appeals for the Federal Circuit. The Federal Circuit found that the district court misconstrued the parallelism limitation language in the claims. It adopted its own claim construction that gave the claims a much broader scope. (APP. 6-7) In

light of its new, broader claim construction, the Federal Circuit reversed the summary judgment in favor of Trinity and determined that Trinity's Aluminator II railway car infringed at least claims 1 and 6 of the '097 patent. "[W]e reverse the judgment of noninfringement and remand the case to the district court for a determination as to damages and for consideration of Johnstown's argument that Trinity's infringement was willful." (APP. 8) The Federal Circuit designated its opinion as unpublished.

Trinity petitioned for rehearing, alleging that it deserved a new trial on infringement and validity. With respect to validity, Trinity contended that the Federal Circuit's broader construction of the claims rendered them more susceptible to attack and that it should be allowed to present prior art evidence and arguments that would not have been admissible under the district court's claim construction that was the basis for the jury trial.

After requiring a response from JAC, the Federal Circuit denied Trinity's petition for rehearing. (APP. 35-40) The court held that Trinity waived the issue of validity by failing to take a cross appeal on that issue. (APP. 39-40)

REASONS FOR GRANTING THE WRIT

This case presents an important issue of appellate procedure that traditionally has been governed by this Court's decisions, rather than by statute or rule. The federal appellate courts have developed a split of authority on this issue, and the Federal Circuit's decision in this

case is on the wrong side of the divide. Its decision conflicts not only with reasoning of other circuits, but with the reasoning of prior decisions of this Court. After dissecting the policy implications of the Federal Circuit's decision, the error of that decision becomes clear.

The Federal Circuit held that Trinity, as appellee, waived the affirmative defense of patent invalidity by failing to file a conditional cross appeal. This Court has suggested in dictum that the failure to file a conditional cross appeal does not result in a waiver where the appellee's displeasure arises only after a reversal of the district court's judgment, as is the case here. Moreover, in the context of patent cases, this Court has explicitly recognized that a defendant need not file a cross petition for certiorari to address the affirmative defense of patent invalidity where the appellate court has found the patent valid but not infringed. Prior to the creation of the Federal Circuit, appellate courts used similar reasoning in unanimously rejecting the Federal Circuit's view here. Although the appellate courts are split as to the necessity for conditional cross appeals, the better view is expressed by those circuits that have rejected the requirement.

I. AN APPELLEE WHO IS SATISFIED WITH THE JUDGMENT OF A DISTRICT COURT SHOULD NOT BE REQUIRED TO FILE A CONDITIONAL CROSS APPEAL TO SEEK REMAND IF THE APPELLATE COURT REVERSES THAT JUDGMENT.

This Court's decisions, not a statute or rule, have established the circumstances under which cross appeals

must be filed. A number of appellate courts have consulted these decisions in approving the use of conditional cross appeals. In a conditional cross appeal, an appellee files a cross appeal raising issues that should be addressed only in the event of appellate reversal or modification of the judgment of the district court. *Hartman v. Duffey*, 19 F.3d 1459, 1465 (D.C. Cir. 1994). Issues raised in a conditional cross appeal ordinarily will be deemed moot and will not be addressed by the appellate court unless it reverses or modifies the judgment of the district court. *See id.* Federal appellate courts thus generally agree that appellees *may* file conditional cross appeals.[2]

Recently, successful appellants have begun to assert that appellees *must* file conditional cross appeals to avoid waiving their right to argue, in the event of reversal, either for a remand for further proceedings or for a modification of the district court's judgment in light of the change in the judgment on appeal. *United States v.*

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[2] Each circuit allows conditional cross appeals. *E.g.*, 1st Circuit: *Parker v. Nashua*, 76 F.3d 9, 14 (1st Cir. 1996); 2nd Circuit: *United States v. Bohn*, 959 F.2d 389, 392-94 (2d Cir. 1992); 3rd Circuit: *Jones & Laughlin Steel Corp. v. Johns-Manville Sales Corp.*, 626 F.2d 280, 290 (3rd Cir. 1980); 4th Circuit: *School Board v. Malone*, 762 F.2d 1210, 1218 n.12 (4th Cir. 1985); 5th Circuit: *United States v. Hill*, 42 F.3d 914, 917 (5th Cir. 1995); 6th Circuit: *United States v. Milledge*, 109 F.3d 312, 315 (6th Cir. 1997); 7th Circuit: *Council 31, AFSCME v. Ward*, 978 F.2d 373, 380 (7th Cir. 1992); 8th Circuit: *Trudeau v. Wyrick*, 713 F.2d 1360, 1369 (8th Cir. 1983); 9th Circuit: *Hilton v. Mumaw*, 522 F.2d 588, 603 (9th Cir. 1975); 10th Circuit: *Stewart v. United States*, 327 F.2d 201, 203 (10th Cir. 1964); D.C. Circuit: *Hartman v. Duffey*, 19 F.3d 1459, 1465 (D.C. Cir. 1994); Fed. Circuit: *United States Surgical Corp. v. Ethicon*, 103 F.3d 1554, 1556 (Fed. Cir. 1997), *petition for cert. filed*, 60 U.S.L.W. 3171 (U.S. Aug. 27, 1997) (No. 97-360).

Fennell, 77 F.3d 510, 510 (D.C. Cir. 1996); *United States v. Bohn*, 959 F.2d 389, 392 (2d Cir. 1992); *Dalle Tezze v. Director*, 814 F.2d 129, 133 (3rd Cir. 1987). Judge Newman of the United States Court of Appeals for the Second Circuit found this issue a "matter of some uncertainty and surprisingly little authority." *Bohn*, 959 F.2d at 392. Similarly, Judge Posner found "no authority" on this issue. *Hartford Acc. and Indem. Co. v. Sullivan*, 846 F.2d 377, 385 (7th Cir. 1988). As will be discussed below, the decision of the Federal Circuit in this case conflicts with the decisions of other federal appellate courts that have decided this issue and with the reasoning of prior decisions of this Court. Because this issue potentially affects every appeal where all or part of the district court's judgment is reversed, this Court should grant certiorari in this case to resolve this important issue of appellate procedure and provide proper guidance to federal appellate courts. *See Cardinal Chemical Co. v. Morton Intern., Inc.*, 508 U.S. 83, 89 (1993) (granting certiorari due to importance of Federal Circuit procedural practice to entire nation). This issue is of particular importance given the Federal Circuit's frequent reconstruction of patent claim language on appeal in the wake of this Court's decision in *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996).

A. The Federal Circuit's Practice Requiring Conditional Cross Appeals Conflicts in Principle with Prior Decisions of this Court.

The Federal Circuit's waiver holding conflicts with prior explicit statements by this Court. Before examining this Court's decisions, a brief summary of the relevant

facts is provided, with a more detailed development of the facts following the case law.

The district court granted summary judgment in favor of Trinity on the issue of literal infringement of the '097 patent and issued judgment in favor of Trinity following a jury trial on the issue of infringement under the doctrine of equivalents. The Federal Circuit held that Trinity waived its right to request a remand on the issue of patent validity by failing to file a conditional cross-appeal. The Federal Circuit so held even though: (1) Trinity was satisfied with the district court's judgment "in favor of the defendant, Trinity Industries, Inc."; (APP. 33) (2) given the district court's claim construction under which the case was tried, Trinity had no legitimate claim of reversible error with respect to the validity finding; and (3) the need for remand was created only by the Federal Circuit's reconstruction of the claims language on appeal, a reconstruction that dramatically expanded the scope of the claims, rendering them much more susceptible to a validity attack.

The Federal Circuit has adopted a practice of requiring a party that wins on the issue of infringement, but loses on the issue of validity to file a cross appeal to avoid waiving the right to address validity. An accused infringer who prevails on the issue of infringement but who seeks modification of the judgment is required to cross appeal to avoid waiving the right to challenge the validity of the patent. *Radio Steel & Mfg. Co. v. MTD Products*, 731 F.2d 840, 843-44 (Fed. Cir. 1984); *Vieau v. Japax, Inc.* 823 F.2d 1510, 1517 n.1 (Fed. Cir. 1987); *see also Shelcore, Inc. v. Durham Industries*, 745 F.2d 621, 623 n.1

(Fed. Cir. 1984). The present case illustrates that the Federal Circuit takes a broad view of its practice, extending the scope beyond that originally established. The *Radio Steel* case appears to only require a cross appeal where a party in Trinity's position seeks reversal or modification of the judgment. 731 F.2d at 844. Here, Trinity did not and does not seek modification of the district court judgment. Instead, Trinity only seeks a remand on an issue that would leave the judgment unchanged should Trinity prevail on remand. The Federal Circuit apparently has extended the scope of its announced practice to require the filing of a cross appeal conditional on reversal of the district court.

The Federal Circuit's rule conflicts in principle with the reasoning of prior decisions of this Court. This Court's longstanding rule is that a party is required to cross-appeal only when it seeks to modify the district court's judgment. *See United States v. American Ry. Express Co.*, 265 U.S. 425, 435 (1924). In fact, "[a] party who receives all that he has sought generally is not aggrieved by the judgment affording the relief and *cannot* appeal from it." *Deposit Guaranty Nat. Bank v. Roper*, 445 U.S. 326, 333 (1980) (emphasis added). "The justification for this rule is quite simple – a party who is happy with the judgment of a court should not have to appeal from it." *Dalle Tezze v. Director*, 814 F.2d 129, 133 (3rd Cir. 1987) (citing Robert L. Stern, *When to Cross-Appeal or Cross-Petition – Certainty or Confusion?*, 87 Harv. L. Rev. 763, 765 (1974)).

In *Stelos Co. v. Hosiery Motor-Mend Corp.*, 295 U.S. 237 (1935), this Court noted that a patent infringement defendant found not to have infringed a patent was not

required to file a cross-petition for certiorari to be able to argue the validity of the patent in this Court. The district court in *Stelos* found the patent invalid and not infringed. *Id.* at 238. On appeal, the Second Circuit affirmed the finding of noninfringement, but apparently found the patent valid. *Id.* at 238-39. This Court observed that because a finding of invalidity would support the judgment of the appellate court, the defendant was allowed to dispute validity without filing a cross-petition for certiorari. "In support of the judgment, the defendants might have urged the point as to invalidity, decided against them in the Circuit Court of Appeals, without applying for a cross-writ of certiorari." *Id.* at 239. The Federal Circuit's rule requiring conditional cross appeals conflicts with this reasoning.

More recently, this Court chose to comment on the use of conditional cross appeals and suggested that cross appeals are not required where the appellee only wishes to raise additional arguments in the event of reversal by the appellate court. In *Bowen v. United States Postal Service*, 459 U.S. 212 (1983), the district court's judgment apportioned damages between a union and an employer based upon their respective shares of a backpay award. *Id.* at 216-17. The Fourth Circuit reversed the finding of liability as to the union. Because of the lack of a conditional cross appeal by the appellee, the Fourth Circuit refused to reapportion the damages such that the employer was responsible for the full award. *Id.* at 217-218. In reversing the Fourth Circuit, the majority "noted in dictum that the Court of Appeals had erred in ruling that the lack of a conditional cross-appeal would have precluded an increase in the judgment against the

employer had the rejection of the judgment against the union remained undisturbed." *United States v. Bohn*, 959 F.2d 389, 393 (2d Cir. 1992) (citing *Bowen*, 459 U.S. at 217-18 n. 7). Similarly, three dissenters noted that a conditional cross appeal was not required. 459 U.S. at 244-45.

Collectively, the *Stelos* and *Bowen* decisions suggest the impropriety of the Federal Circuit's requirement that an appellee file a conditional cross appeal on the issue of validity to avoid waiving that argument. These cases stand for the proposition that a litigant who is happy with a judgment need not appeal to preserve the right to make arguments that only become relevant because the appellate court reverses the judgment of the district court. The policies underlying these decisions are sound. Because the present case illustrates some of those policies well, they will be discussed in that context.

Trinity was satisfied with the judgment of the district court. The judgment on the jury verdict stated, "IT IS ORDERED AND ADJUDGED That judgment be entered in favor of the defendant, Trinity Industries, Inc. Judgment is hereby entered in accordance with the above verdict." (APP. 33) The district court chose to issue a general judgment in favor of Trinity on the jury verdict rather than entering a judgment that the '097 patent was not infringed and not invalid. Given the judgment actually entered by the district court, Trinity had achieved all it could achieve – a judgment "entered in favor of the defendant."

The Federal Circuit's decision dramatically changes the legal question of validity. The Federal Circuit set aside the district court's claim interpretation and adopted

a much broader claim construction. By broadening the claims, the Federal Circuit made it more likely that the '097 patent was invalid. Broader claims have a greater potential to encompass prior art, rendering the patent invalid if they do so. Accordingly, broadening claims makes a greater universe of prior art relevant to the infringement issue. Here, remand is required to allow Trinity to present additional evidence of invalidity under the broadened claim interpretation and obtain a jury verdict of invalidity pursuant to the new claim construction.

Absent the holding of waiver in this case, the Federal Circuit would have remanded the case for the reasons just described. The Federal Circuit has recognized that remand is appropriate when an erroneous claim construction is reversed on appeal. "When the prior art is compared with erroneously interpreted claims, findings of differences between the prior art and the claims will necessarily be clearly erroneous. When the sole error lies in claim interpretation, a remand for comparison of the prior art with properly interpreted claims is *required*." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 (Fed. Cir. 1987) (emphasis added). Remand is required because a different universe of prior art becomes relevant when claim interpretation is changed.

Such a remand would not be futile. Under the broadened claim construction adopted by the Federal Circuit, the claims of the '097 patent are invalid under 35 U.S.C. §§ 102 or 103 because they read on the railway car disclosed by the '660 prior art patent, either alone or in combination with other prior art adduced by Trinity at

trial, including a prior art car made by Pullman that was not before the examiner who issued the '097 patent.[3]

This Court's decision in *Byrd v. Blue Ridge Rural Electric Cooperative*, 356 U.S. 525 (1958), is on point. There, as here, the appellate court reversed a legal finding by the district court and directed a judgment for the appellant without remanding to provide the appellee an opportunity to present relevant evidence under the revised legal finding. *Id.* at 530-31. As in this case, a different body of evidence was relevant to the legal issue in *Byrd* after the reversal on appeal altered the relevant legal standard. *Id.* at 531-32. This Court recognized that the

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[3] Under the district court's claim construction (which was included in the charge to the jury), the railway car disclosed by the '660 prior art patent is distinguishable from the claimed invention of the '097 patent because the '660 prior art patent car, like the Aluminator II, had troughs that were angled relative to the center sill and whose axes were, therefore, not parallel to the axis of the center sill. Indeed, this is precisely the reason why the district court found that the Aluminator II railway car did not infringe.

Under the Federal Circuit's reconstruction of the claims on appeal, however, the '097 patent covers cars with troughs that are inclined relative to the rail, such as the '660 prior art railway car and the Trinity Aluminator II railway car. Because the Federal Circuit broadened the '097 patent's claims, it swept the '660 prior art reference and other prior art into their scope, thus invalidating the claims.

The monumental change in significance of the '660 prior art reference due to the change in claim interpretation illustrates the point made above – a change in claim interpretation makes different evidence relevant on the issue of validity so a remand for a new trial is appropriate when the claim construction changes.

petitioner in *Byrd* was "fully justified . . . in not coming forward with proof of his own at that stage of the proceedings, for he had nothing to meet under the District Court's view of the statute." *Id.* at 533.

Because of the change in claim scope, Trinity was fully justified in not presenting the same case on validity that it would present on remand. Indeed, Trinity could not have presented a different validity case at trial. The district court confirmed by order in limine that it would not allow argument or evidence under any claim construction but its own. *See also Brinley v. Commissioner of Internal Revenue*, 782 F.2d 1326, 1336 (5th Cir. 1986) (remanding for new trial when legal test changed on appeal because justice requires opportunity to present evidence in light of appropriate standard).

Three policies underlying this Court's prior decisions thus become apparent. First, in many cases a conditional cross appeal would be nothing more than a formality – it would prevent a waiver but remand would be required anyway. The fact that remand would have been required on the issue of validity had the Federal Circuit not found waiver illustrates the folly of the waiver finding. Had Trinity filed a conditional cross appeal, the Federal Circuit would not have been able to decide the validity issue because, as just explained, a whole new universe of prior art would have been relevant. "[A] remand . . . is required." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 (Fed. Cir. 1987). This Court should not condone a waiver rule that serves no other function than setting up a meaningless procedural hoop through which to jump.

The rule that the Federal Circuit applied in this case would require appellees in Trinity's position to file conditional cross-appeals the essence of which would be the following: "Trinity has no complaint about the jury's finding that the '097 patent was not invalid. There is sufficient evidence to support that finding. The trial court did not err with respect to the admission or exclusion of evidence nor with respect to the charge. Indeed, Trinity can point to no error. Trinity cross-appeals only in the unlikely event that this court reconstrues the claims on appeal in a way that would make a new trial of validity appropriate."

Second, conditional cross appeals put appellees in a hopeless position. The appellee would be forced to anticipate every possible appellate outcome and make arguments in its favor as to each outcome. With page limits decreasing, that would be a monumental task in many appeals. Moreover, an appellee cannot possibly anticipate every possible action that an appellate court might take on appeal. In fact, as Federal Circuit judges have observed, the Federal Circuit sometimes adopts a claim construction on appeal that neither party has suggested. *Exxon v. Lubrizol*, 64 F.3d 1553, 1568-70 (1995) (Nies, J., dissenting). Because an appellee cannot possibly address a potential appellate outcome that neither party argued for, it could not always protect itself with a conditional cross appeal.

Third, requiring conditional cross appeals to avoid waiver "would impose upon appellate courts the burden of additional appeals from favorable decisions prosecuted by litigants attempting to insulate their judgments from actions like that taken here by the Court of Appeals."

Bowen v. United States Postal Service, 459 U.S. 212, 245 (1983) (White, J., Marshall, J., & Blackmun, J., dissenting); *see also United States v. Bohn*, 959 F.2d 389, 393-94 (2d Cir. 1992) (noting burdens on courts and litigants from mandatory conditional cross appeal rule). Besides the burden on appellate courts, appellees would also face additional burden and expense writing conditional cross appeal briefs on issues that most likely will never be addressed. These concerns are likely to be magnified as to some parties, such as the government in criminal cases. *See United States v. Bohn*, 959 F.2d 389, 393 (2d Cir. 1992).

B. The Federal Circuit's Practice Requiring Conditional Cross Appeals Directly Conflicts with Decisions of Other Federal Courts of Appeals.

The federal appellate courts are split over the requirement of a conditional cross appeal, but the vast majority of case law suggests that the Federal Circuit's practice requiring conditional cross-appeals is incorrect. The rule applied by the Federal Circuit requiring that Trinity file a conditional cross appeal is consistent with the decision of the Fourth Circuit in *Bowen v. United States Postal Service*, 642 F.2d 79 (4th Cir. 1981), *rev'd*, 459 U.S. 212 (1983). The views of the Fourth Circuit and Federal Circuit on this issue differ from those of other circuits. In general, "[c]ross appeal . . . is not required to preserve the right to orderly disposition of issues that become relevant only because of reversal." 15A Charles A. Wright, et al., *Federal Practice and Procedure* § 3904, at 203-04 (1992).

Prior to the creation of the Federal Circuit, several federal appellate courts addressed the issue of whether

an accused infringer who prevails on the issue of infringement in the district court must file a cross appeal to preserve the right to allege invalidity in the appellate court. The apparently unanimous view was that an appellee did not have to file a cross appeal to preserve its right to argue validity on appeal.[4] These cases create a direct conflict with the Federal Circuit's requirement of conditional cross appeals.

In other contexts, federal appellate courts have likewise rejected a suggestion that a conditional cross appeal is required to avoid waiving issues that arise only because of reversal by an appellate court. Several circuits have addressed the issue in connection with the important area of criminal sentencing. Criminal defendants have questioned whether the government could, in the absence of a conditional cross appeal, argue for a change in one component of the sentencing decision if the appellate court chooses to change another component of the sentence. *E.g., United States v. Bohn*, 959 F.2d 389, 392 (2d Cir. 1992). Several circuits have held that by failing to file a conditional cross appeal, the government does not waive the right to seek a sentence enhancement after a

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[4] 5th Circuit: *Mannix Co. v. Healey*, 341 F.2d 1009, 1013 (5th Cir. 1965); *Graham v. Cockshutt Farm Equipment*, 256 F.2d 358, 359 (5th Cir. 1958); *Guiberson Corp. v. Equipment Engineers*, 252 F.2d 431, 432 (5th Cir. 1958); 6th Circuit: *Maytag Co. v. Murray Corp.*, 318 F.2d 79, 80 (6th Cir. 1963); *Bede v. Baker & English, Inc.*, 274 F.2d 833, 835 (6th Cir. 1960); *Merco Norstrom Valve Co. v. W.M. Acker Org.*, 131 F.2d 277 (6th Cir. 1942); 7th Circuit: *Erie Technological Products v. Die Craft Metal Products*, 461 F.2d 5, 6 & 11 (7th Cir. 1972); 9th Circuit: *see M.O.S. Corp. v. John I. Haas Co.*, 375 F.2d 615, 617 (9th Cir. 1967).

partial reversal of the judgment on appeal.[5] Federal appellate courts have also rejected the mandatory conditional cross appeal rule in civil cases.[6] Collectively, these cases employ reasoning similar to that advanced by Trinity above and express the better rule – that conditional cross appeals, while allowed, are not required to avoid waiver of issues that become relevant due to reversal on appeal.

C. Conclusion

Overall, the Federal Circuit's practice of requiring a conditional cross appeal by an appellee to avoid waiver of the patent validity issues is not sound. Prior decisions of this Court suggest that the practice is wrong as do a number of decisions from other appellate courts. Only one other appellate court is in agreement with the Federal Circuit. The Federal Circuit's rule is bad policy. First, in many cases a conditional cross appeal would represent nothing more than satisfaction of a procedural hurdle and do nothing to advance resolution of the case. Second,

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[5] *United States v. Bohn*, 959 F.2d 389, 393-94 (2d Cir. 1992); *United States v. Fennell*, 77 F.3d 510, 510 (D.C. Cir. 1996); *United States v. Hill*, 42 F.3d 914, 917 n.8 (5th Cir. 1995); *United States v. Milledge*, 109 F.3d 312, 315 (6th Cir. 1997).

[6] *Butler v. First National Bank of Commerce*, 552 F.2d 1112, 1114 (5th Cir. 1977) (rejecting as frivolous suggestion that appellee, by failing to file cross appeal, lost right to pursue claims only relevant due to reversal); *Dalle Tezze v. Director*, 814 F.2d 129, 133 (3rd Cir. 1987) (no cross appeal required to urge remand); *Landsberg v. Scrabble Crossword Game Players, Inc.*, 802 F.2d 1193, 1197 (9th Cir. 1986) (no waiver due to appellee's failure to file cross appeal on alternative theory of recovery).

mandatory conditional cross appeals place appellees in the hopeless position of trying to anticipate every possible action by the appellate court while facing a finding of waiver if they fail in their anticipation. Third, mandatory conditional cross appeals would greatly increase the work load of courts and litigants alike with little or no benefit to appellate practice.

CONCLUSION

For the reasons stated above, the petition should be granted.

Respectfully submitted,

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NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

97-1070, -1071

JOHNSTOWN AMERICA CORPORATION and JAC PATENT CORPORATION,

Plaintiffs-Appellants,

v.

TRINITY INDUSTRIES, INC.,

Defendant-Cross-Appellant.

DECIDED: May 28, 1997

Before ARCHER, *Chief Judge*, CLEVENGER, and SCHALL, *Circuit Judges*.

SCHALL, *Circuit Judge*.

DECISION

Johnstown America Corporation and JAC Patent Corporation (collectively "Johnstown") appeal from the decision of the United States District Court for the Western District of Pennsylvania granting partial summary judgment on the issue of literal infringement in favor of Trinity Industries, Inc. ("Trinity"). *Johnstown Am. Corp. v. Trinity Indus. Inc.*, 865 F. Supp. 1159 (W.D. Pa. 1994).

Johnstown also appeals the denial of its motion for judgment as a matter of law (JMOL), and the denial of its motion to set aside the jury verdict (JNOV)[1] and its motion in the alternative for a new trial. *Johnstown Am. Corp. v. Trinity Indus. Inc.*, No. 92-587J (Sept. 13, 1996). Johnstown had requested JMOL and JNOV, or a new trial, on the issue of infringement under the doctrine of equivalents. We *reverse* and *remand*.

DISCUSSION

I.

Johnstown sued Trinity for infringement of United States Patent No. 4,361,097 (the '097 patent). The '097 patent is directed to a gondola car suitable for rotary unloading. The floor of the car that is the subject of the invention contains a pair of concave troughs running the length of the car and separated by a center sill.

Claims 1 and 6 are the only independent claims of the patent. Claim 1 reads as follows:

> A railway car for carrying bulk materials having a pair of side walls and a pair of end walls supported by spaced trucks, the improvement comprising a floor structure having
>
> (a) a center sill extending longitudinally over said trucks,
>
> (b) a pair of concave floor panels between said trucks, each panel forming a longitudinal

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[1] Pursuant to the 1991 amendments to Rule 50, the former JNOV is now known as a renewed motion for judgment as a matter of law (JMOL).

> curvilinear trough having closed ends, the longitudinal axis of each of said troughs extending parallel to the longitudinal axis of said center sill.

Claim 6 recites:

> A floor for a railway car comprising a center sill and a pair of longitudinal curvilinear troughs having closed ends secured to opposite sides of said center sill with the longitudinal axes of said troughs extending parallel to the longitudinal axis of the center sill.

On September 13, 1993, Trinity moved for summary judgment, arguing that the accused gondola car, the Trinity Aluminator II, did not literally infringe the '097 patent and that Johnstown's doctrine of equivalents claim was barred by prosecution history estoppel. *Johnstown*, 865 F. Supp. at 1160.

On September 2, 1994, the district court granted summary judgment in favor of Trinity on the issue of literal infringement. *Id.* In so doing, the court focused on the question of whether the accused gondola met the limitation of claims 1 and 6 that the longitudinal axes of the troughs be parallel to the longitudinal axis of the center sill.[2] The court construed the claim term "axis" as defining "a line about which a geometrical figure is symmetrical." *Id.* at 1163 (quoting *American Heritage Dictionary of Science* 55 (1986)). The court determined that because the Aluminator II troughs slope up from either end of the car to the middle, a single axis about which each trough is

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[2] It was undisputed that the other limitations of claims 1 and 6 were met in the Aluminator II.

symmetrical cannot be drawn. *Id.* The court thus adopted Dr. Glenn Sinclair's[3] interpretation that each trough of the Aluminator II has two axes, each of which slopes up at the angle of inclination of the troughs. *Id.* Accordingly, the court found that the Trinity Aluminator II does not literally infringe because the longitudinal axes of its troughs do not extend parallel to the longitudinal axis of its center sill. *Id.* at 1163-64.

Addressing the issue of infringement under the doctrine of equivalents, the district court concluded that prosecution history estoppel did not bar the application of the doctrine. *Id.* at 1165-66. The court reasoned that although the term "longitudinal axis" was added during prosecution, the parallelism requirement existed before the claims were amended. *Id.* The court opined that the amendment was not made to overcome prior art, as Trinity contended,[4] but rather to "simplify and clarify the parallelism requirement." *Id.* at 1165.

Because the court did not resolve the doctrine of equivalents issue on motion for summary judgment, a trial on the merits ensued. During the trial there were a number of objections to the admissibility of evidence. Requests by both parties for JMOL were denied. The

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[3] At the time he executed his affidavit, Dr. Sinclair was a professor of mechanical engineering at Carnegie Mellon University. *Id.* at 1163.

[4] Trinity argued that the limitation that the longitudinal axes of the troughs extend parallel to the longitudinal axis of the center sill was added to overcome a 35 U.S.C. § 102 rejection based on United States Patent No. 1,412,660 (the Kuehner patent). *Id.* at 1164-65.

court instructed the jury, with objections by both parties, on the issue of infringement under the doctrine of equivalents. On August 15, 1996, the jury returned a verdict of noninfringement under the doctrine of equivalents. Johnstown filed a JNOV motion and in the alternative a motion for a new trial. On September 13, 1996, the court denied the motions. This appeal followed.

II.

Determining whether a patent is infringed entails a two-step analysis. "First, the claim must be properly construed to determine its scope and meaning. Second, the claim as properly construed must be compared to the accused device or process." *Carroll Touch, Inc. v. Electro Mechanical Sys.*, 15 F.3d 1573, 1576, 27 USPQ2d 1836, 1839 (Fed. Cir. 1993). Claim construction is an issue of law, which we review de novo. *Markman v. Westview Instr., Inc.*, 52 F.3d 967, 979, 34 USPQ2d 1321, 1329 (Fed. Cir. 1995) (in banc), *aff'd*, 116 S. Ct. 1384 (1996). Comparing the properly construed claims to the accused device or process presents a question of fact. *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1541, 25 USPQ2d 1241, 1251 (Fed. Cir. 1992).

In this case, the district court decided the issue of literal infringement on motion for summary judgment. Summary judgment is appropriate when "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). We review the district court's grant of summary judgment de novo to determine whether the summary judgment standard was properly applied. *Lantech*

Inc. v. Keip Mach. Co., 32 F.3d 542, 545, 31 USPQ2d 1666, 1669 (Fed. Cir. 1994). Because there are no material facts in dispute, the issue before us is one of law: the correct construction of the "longitudinal axis" limitation of claims 1 and 6.

As already seen, claims 1 and 6 recite the limitation that the longitudinal axes of the troughs extend parallel to the longitudinal axis of the center sill. Neither the specification nor the prosecution history sheds light on the term "longitudinal axis." Recognizing this, the district court adopted what it perceived to be the common definition of the term "axis." We agree that if a patentee does not define a term in the specification or prosecution history, it is proper for the trial court to ascribe to the term its common meaning. *See Environtech Corp. v. Al George, Inc.*, 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984) ("Words in a claim 'will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently.' " (citation omitted)). We conclude, however, that the district court erred in adopting a definition for "axis" that corresponds to the definition of "axis of symmetry" as opposed to the definition of "longitudinal axis." Whereas the district court's definition implicitly requires that the body through which the axis penetrates be symmetrical, the dictionary definition of "longitudinal axis" conveys no such requirement. Instead, the definition, which defines "longitudinal axis" as "[a]n axis along the lengthwise direction of the figure or body, usually passing through its center of gravity," only requires an ascertainable lengthwise direction in which the longitudinal axis can be drawn. Cyril M.

Harris, *Dictionary of Architecture & Construction* 500 (2d ed. 1993).

Therefore, reading the claim in light of the common meaning for the term "longitudinal axis," we conclude that if a lengthwise direction can be ascertained for a given trough, then a single longitudinal axis can be drawn. If a longitudinal axis can be drawn for each trough, such that the longitudinal axis of each trough is parallel to the longitudinal axis of the center sill, then the parallelism limitation of claims 1 and 6 is satisfied.

Turning to the second part of the infringement analysis, we hold that the parallelism limitation recited in claims 1 and 6 reads on the Aluminator II. The fact that the bottom of each of the troughs is sloped does not affect our ability to draw a single longitudinal axis from one end of each trough to its other end. Because the lengthwise direction of each trough in the Aluminator II is parallel to the lengthwise direction of the center sill, the longitudinal axes are necessarily parallel. Trinity does not dispute the fact that the Aluminator II contains all limitations absent the parallelism limitation. Therefore, we hold claims 1 and 6 literally infringed.

Our holding of literal infringement moots Johnstown's claim that the district court improperly denied its JMOL and JNOV motions, as well as its motion for a new trial, all of which were related to the issue of infringement under the doctrine of equivalents. *See Transmatic, Inc. v. Gulton Indus. Inc.*, 53 F.3d 1270, 1275, 35 USPQ2d 1035, 1039 (Fed. Cir. 1995) (reversing the district court's

finding of no literal infringement and consequently vacating "as moot that part of the court's decision relating to infringement under the doctrine of equivalents").

For the foregoing reasons, we reverse the judgment of noninfringement and remand the case to the district court for a determination as to damages and for consideration of Johnstown's argument that Trinity's infringement was willful.

Each party shall bear its own costs.

JOHNSTOWN AMERICA CORPORATION, Plaintiff,

v.

TRINITY INDUSTRIES, INC., Defendant.

Civ. A. No. 92-587J.

United States District Court,
W.D. Pennsylvania.

Sept. 2, 1994.

Holder of patent describing gondola-style, top-dumping railway car brought infringement action against competitor. On competitor's motion for summary judgment, the District Court, D. Brooks Smith, J., held that: (1) patent was not literally infringed, but (2) prosecution history estoppel did not bar patentee from claiming infringement under doctrine of equivalents.

Motion granted in part and denied in part.

Raymond G. Hasley, Rose, Schmidt, Hasley & DiSalle, P.C., Pittsburgh, PA, for plaintiff.

Larry D. Carlson, Robert H. Johnston III, Baker & Botts, L.L.P., Dallas, TX, Frederick N. Egler, Egler, Garrett & Egler, Pittsburgh, PA, for defendant.

OPINION

D. BROOKS SMITH, District Judge.

Seeking injunctive relief and damages, Johnstown America Corporation ("Johnstown") has sued Trinity Industries, Inc. ("Trinity") for patent infringement. Johnstown claims that Trinity's Aluminator II railway car

infringes one or more of the claims of Johnstown's United States Patent No. 4,361,097 (the " '097 patent"), either literally or under the doctrine of equivalents. By counterclaim, Trinity seeks a declaratory judgment that the Aluminator II does not infringe any claim of the '097 patent. Trinity has filed a motion for summary judgment, arguing that no literal infringement exists as a matter of law and that Johnstown's claim under the doctrine of equivalents is barred by prosecution history estoppel.

I will grant Trinity's motion in part, because I agree that the Aluminator II does not literally infringe the '097 patent. I conclude, however, that prosecution history estoppel does not apply in this case. Accordingly, Johnstown may pursue its infringement claim under the doctrine of equivalents.

I. FACTS

Johnstown's '097 patent, obtained in 1982, describes a gondola-style, top-dumping railway car commonly used to transport bulk materials, such as coal and gravel.[1] U.S. Patent No. 4,361,097, Docket No. 43, Exh. A, col. 1, lines 5-7. Johnstown's invention improved upon previous railway cars, which were designed as rectangular boxes with either flat bottoms or depressed centers. *Id.*, col. 1, lines 11-19. The '097 patent improved a car's carrying capacity and lowered its center of gravity by "eliminating the

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[1] For simplicity I will refer to "Johnstown's" prosecution of the '097 patent. In fact, the '097 patent was originally assigned to Bethlehem Steel Corporation and only later assigned to Johnstown. Kurtz depo., Docket No. 49, Exh. H, at 44.

hopper chutes, door frames, etc., from a conventional high side hopper car and substituting therefor a pair of concave troughs between the center sill and sides of the car." *Id.*, col. 1, lines 40-43. Claims 1 and 6 of the '097 patent require that the "longitudinal axis" of each trough be parallel to the "longitudinal axis" of the center sill. *Id.*, col. 3, lines 5-7; *id.*, col. 4, lines 8-9. Diagrams of the '097 patent are attached hereto as Exhibit A.

Trinity built the Aluminator II under a patent it obtained in 1993. U.S. Patent No. 5,178,084, Docket No. 43, Exh. D. Like the '097 patent, the Aluminator II is a gondola-style, top-dumping railway car with concave troughs on either side of the center sill. The troughs on the Aluminator II, however, are not parallel to the center sill. Instead, each trough slopes up from the ends of the car, where the trough is deeper, rising toward the middle, where it forms an angle of approximately 3°. Beck affidavit, Docket No. 41, ¶ 23. Diagrams of the Aluminator II are attached hereto as Exhibit B. Trinity's patent states that the sloping troughs are an improvement over the '097 patent:

> This invention provides an improved gondola car of the rotary dump type that includes a pair of troughs that extend between the trucks supporting the railway car and are disposed along each side of a center sill that extends the full length of the car. The troughs of the car of this invention, contrary to those illustrated in the '097 patent are deeper adjacent to the trucks than at the latitudinal center line of the car. The ability to make the troughs deeper near the trucks provides a greater capacity car having a lower center of gravity or, on the other hand,

> provides a car having the same capacity with a lower overall height to reduce the drag effect from the wind as the car is being pulled along the tracks.

U.S. Patent No. 5,178,074, Docket No. 43, Exh. D, col. 1, lines 28-40.

Johnstown's claim for literal infringement turns on whether the longitudinal axes of the "bent" troughs on the Aluminator II are parallel to the longitudinal axis of the car's center sill, as required by claims 1 and 6 of the '097 patent. If the axes are not parallel, then Trinity has not literally infringed the '097 patent. While the parties seem to agree on the meaning of "longitudinal axis" of a center sill, they disagree over the meaning of "longitudinal axis" of a trough, as that term is found in the '097 patent. Further, the parties agree that the prosecution history of the '097 patent provides insight into the meaning of the disputed term; they disagree, however, on the nature of that insight.

Prosecution History of the '097 Patent

The '097 patent contains nine claims. In Johnstown's original application, claims 1 and 6 read as follows:

> 1. A railway car for carrying bulk material having a pair of side walls and a pair of end walls supported by spaced trucks, the improvement comprising a floor structure having
>
> (a) a center sill extending longitudinally over said trucks,
>
> (b) a pair of concave floor panels, each panel extending parallel to said center sill and

between one side of said center sill and one of said side walls.

6. A floor for a railway car comprising a center sill and a pair of concave floor panels secured to opposite sides of and extending parallel to said center sill.

Patent application dated June 17, 1977, Docket No. 43, Exh. B, at 7-8.

In a decision mailed April 21, 1978, the federal Patent and Trademark Office rejected all nine claims. Decision by Examiner Howard Beltran, Docket No. 43, Exh. B, at 1. Although the examiner did not state explicitly his reason for rejecting claims 1 and 6, he provided an explanatory citation to 35 U.S.C. § 102 and United States Patent No. 1,412,660, registered in 1922 by Arthur T. Kuehner (the "Kuehner patent"). *Id.* at 2. Trinity contends, and Johnstown does not disagree, that a patent examiner must reject an application under 35 U.S.C. § 102 when he or she determines that the claimed invention is "anticipated by a single piece of prior art" – i.e., when the prior art contains every element of the claimed invention. Beck affidavit, Docket No. 41, at ¶ 12. Thus, we know that the examiner rejected the original language of claims 1 and 6 because he determined that the Kuehner patent contained every element of those claims. *See id.* ¶ 17. Diagrams of the Kuehner patent are attached hereto as Exhibit C.

After its original patent application was rejected, Johnstown, through its agent, John Iverson, sent a responsive letter to the Commissioner of Patents and Trademarks. Iverson's letter proposed to amend claims 1

and 6 to overcome the examiner's decision of unpatentability by "better defin[ing]" Johnstown's invention. Letter dated July 13, 1978 from John Iverson to Commissioner of Patents and Trademarks, Docket No. 43, Exh. B, at 2. Iverson explained that Johnstown's invention, a railway car meant to be inverted and top-dumped, was completely different from the Kuehner car, a bottom dumper. Although both inventions used troughs, those on the Kuehner car ended in doors meant to be opened to discharge cargo beneath the car. The troughs on Johnstown's car, on the other hand, had closed ends; their purpose was not to facilitate dumping but to increase carrying capacity and lower the car's center of gravity. *Id.* Iverson proposed to amend claims 1 and 6 as follows:

> 1. A railway car for carrying bulk material having a pair of side walls and a pair of end walls supported by spaced trucks, the improvement comprising a floor structure having
>
> (a) a center sill extending longitudinally over said trucks,
>
> (b) a pair of concave floor panels, each panel ~~extending parallel to said center sill and between one side of said center sill and one of said side walls forming a longitudinal closed end curvilinear trough extending parallel to and along one side of said center sill.~~
>
> 6. A floor for a railway car comprising a center sill and a pair of ~~concave floor panels longitudinal closed end curvilinear troughs~~ secured to opposite sides of and extending parallel to said center sill.

Id. at 1.

Iverson's letter reveals that the reason behind these proposed amendments was to clarify that the ends of the troughs on the Johnstown invention were closed, in contrast to the openable troughs on the Kuehner car.[2] Iverson's proposed amendments in no way affected the requirement that the troughs of the car be parallel to the center sill. The parallelism requirement distinguished Johnstown's car from the Kuehner patent, which claimed "[downwardly] inclined trough shaped chute[s] extending longitudinally of the car." U.S. Patent No. 1,412,660, Docket No. 43, Exh. C, at 3, lines 23-24. The next item in the file history is a letter dated September 25, 1978 from Patent Examiner Francis Husar, noting that "[t]he following changes have been made after a telephone conference with applicant's attorney Mr. John I. Iverson on September 20, 1978 [which changes] further define the structural relationships." Husar's letter notes the following amendments to claims 1 and 6:

> 1. A railway car for carrying bulk material having a pair of side walls and a pair of end walls supported by spaced trucks, the improvement comprising a floor structure having
>
> (a) a center sill extending longitudinally over said trucks,
>
> (b) a pair of concave floor panels ~~between said trucks~~, each panel forming a longitudinal ~~closed end~~ curvilinear trough ~~having closed~~

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[2] Additionally, Iverson recommended using the word "curvilinear" to broaden independent claims 1 and 6 to encompass troughs shaped other than as circles. (The word "circular" appears in dependent claims 4, 7, and 8.) Iverson affidavit, Docket No. 46, ¶ 14.

~~ends, the longitudinal axis of each of said troughs~~ extending parallel ~~to and along one side of said center sill to the longitudinal axis of said center sill~~.

6. A floor for a railway car comprising a center sill and a pair of longitudinal ~~closed end curvilinear troughs secured to opposite sides of and extending parallel to said center sill curvilinear troughs having closed ends secured to opposite sides of said center sill with the longitudinal axes of said troughs extending parallel to the longitudinal axis of said center sill~~.

Letter dated Sept. 25, 1978 to Joseph O'Keefe from Francis Husar, Docket No. 43, Exh. B, at 1-2. The parties disagree over the meaning of this amendment, which added the nettlesome term "longitudinal axis."

II. DISCUSSION

Entry of summary judgment is proper " 'if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue of material fact and that the moving party is entitled to a judgment as a matter of law.' " *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1986) (quoting Fed.R.Civ.P. 56(c)). "[T]he mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no *genuine* issue of *material* fact." *Id.* at 247-48, 106 S.Ct. at 2510. An issue of fact is "genuine" if the evidence is such that a reasonable jury might return a verdict for the non-moving party. *Id.*

at 257, 106 S.Ct. at 2515; *Equimark Commercial Fin. Co. v. C.I.T. Fin. Servs. Corp.*, 812 F.2d 141, 144 (3d Cir.1987).

Once the moving party has satisfied its burden of identifying evidence that demonstrates the absence of a genuine issue of material fact, the non-moving party is required to go beyond the pleadings by way of affidavits, depositions, and answers to interrogatories to identify specific material facts giving rise to a genuine issue. *Celotex Corp. v. Catrett*, 477 U.S. 317, 324, 106 S.Ct. 2548, 2553, 91 L.Ed.2d 265 (1986). When Rule 56(e) shifts the burden of proof to the non-moving party, it must produce evidence to show the existence of every essential element which it must prove at trial. *Equimark*, 812 F.2d at 144.

A. *The Literal Infringement Claim*

Literal infringement requires that the accused device embody every element of the patentee's claim. *Townsend Eng'g Co. v. Hitec Co.*, 829 F.2d 1086, 1090 (Fed.Cir.1987). Trinity maintains that the Aluminator II does not literally infringe claims 1 or 6 of the '097 patent because the longitudinal axes of the troughs on the Aluminator II are not parallel to the longitudinal axis of the car's center sill. Johnstown disagrees, contending that the axes are indeed parallel.

This dispute boils down to the correct definition of "longitudinal axis" of a trough. Both parties have submitted affidavits by engineering experts. Trinity has submitted the affidavit of Dr. Glenn Sinclair, a professor of mechanical engineering at Carnegie Mellon University. Johnstown has submitted the affidavit of Dr. James Romualdi, a professor of civil engineering at Carnegie

Mellon and president of Romualdi, Davidson and Associates, Inc., an engineering consulting firm.

Dr. Sinclair defines the longitudinal axis of a trough as "the straight line running lengthwise through the centers of the vertical cross sections at the ends of the trough. The center of the vertical cross section at the end of a trough may be taken as either the centroid of the cross section, or the center of gravity." Sinclair affidavit, Docket No. 40, ¶ 10. Dr. Sinclair states that the longitudinal axis of a trough in the Aluminator II is in fact *two* axes, each of which slopes up (with the trough) from one end of the car to the middle. Because these two axes slope, they are not parallel to the horizontal axis of the center sill. *Id.* at ¶¶ 9, 17, 23; supplemental Sinclair affidavit, Docket No. 54, ¶ 11.

Dr. Romualdi neither disagrees with Dr. Sinclair's definition nor provides his own. Indeed, he cites Dr. Sinclair's definition with apparent approval. *See* Romualdi affidavit, Docket No. 47, ¶¶ 13, 14, 17, 20, 22. When Dr. Romualdi applies that definition to the troughs in the Aluminator II, however, he reaches a conclusion different from Dr. Sinclair's. Dr. Romualdi maintains that "the straight line running lengthwise through the centers of the vertical cross sections at the ends of the trough" is exactly that: a straight line running from the center of one end of the trough to the center of the other end, no matter how many bends or twists or turns the trough might take. Because a trough in the Aluminator II starts and ends at the same height above the center sill, Dr. Romualdi's interpretation of the longitudinal axis of each trough is a horizontal line. Accordingly, it is parallel to the horizontal longitudinal axis of the center sill. *Id.* ¶¶ 17, 22.

I conclude that Dr. Sinclair's definition and interpretation of "longitudinal axis" of a trough are correct. I base my determination on the geometrical definition of "axis": "a line about which a geometrical figure is symmetrical." *American Heritage Dictionary of Science* 55 (1986), copy attached as Exh. D to Sinclair affidavit, Docket No. 40. In the Aluminator II, the line about which each trough is symmetrical cannot be, as a matter of geometry, a horizontal line from one end of the trough to the other. That would be the case only for a horizontal trough, as in the '097 patent. Once one bends the trough, as in the Aluminator II, the trough becomes symmetrical about *two* lines, each of which slopes up (with the trough) from either end of the car to the middle. Determining a longitudinal axis in a solid figure which is, as Dr. Sinclair states, "geometrically continuous," such as a cylinder or a cone, is different from determining a longitudinal axis in a geometrically discontinuous figure, such as a "bent" cylinder or a cone.[3] "[T]he method of locating a longitudinal axis must be applied to *each of the parts of the floor structure* in the Aluminator II car that are separated by the geometric discontinuity." Supplemental Sinclair affidavit, Docket No. 54, at ¶ 11 (emphasis added).[4]

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[3] Geometric discontinuity, not the number of troughs, is the reason why each trough on the Aluminator II has two longitudinal axes. Thus, whether the Aluminator II technically has two troughs, as Johnstown contends, or four troughs, as Trinity contends, is immaterial.

[4] In addition to Dr. Romualdi's affidavit, Johnstown has submitted portions of the depositions of two of the three inventors of the '097 patent, Robert Dorian and Richard Jones, who testified that they define "longitudinal axis" of a trough as the line one sees when one looks at a trough from the top of the

My conclusion is based on geometry. It does not derive from a credibility determination made after comparing the curricula vitae of the two experts. Indeed, both parties' experts present impressive credentials. Because the experts disagree, one might mistakenly conclude that the question of which party has correctly defined "longitudinal axis" of a trough is a question of fact to be determined by a jury after hearing testimony from both sides' experts. Claim interpretation is, however, a question of law. *See, e.g., Texas Instrs., Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed.Cir.1993). Claim interpretation includes determining the meaning of a term in a claim. Even when such a determination requires

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car, rather than from the side. Dorian depo., Docket No. 49, Exh. J, at 46; Jones depo., Docket No. 49, Exh. I, at 93.

I find no merit to Johnstown's alternative definition. To begin with, Johnstown supports its "top-view" definition not with any scientific proof but with the self-serving statements of the inventors of the '097 patent. "[L]itigation-induced pronouncements of [an] inventor . . . have no effect on what the words of that document in fact do convey and have conveyed during its term to the public." *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed.Cir.1984); *accord Senmed, Inc. v. Richard-Allan Med. Indus.*, 888 F.2d 815, 819 n. 8 (Fed.Cir.1989). Furthermore, neither Dorian nor Jones has any special insight into the meaning of the term "longitudinal axis" because that term was not in the original application and neither Dorian nor Jones suggested that the application be amended with that language. Indeed, both men testified that they did not know why the term "longitudinal axis" was added. Dorian depo., Docket No. 54, at 36; Jones depo., Docket No. 54, at 66, 69. Finally, such a definition is illogical; it completely ignores the fact that an "axis" is "a line about which a geometrical figure is symmetrical." *American Heritage Dictionary of Science* 55 (1986), copy attached as Exh. D to Sinclair affidavit, Docket No. 40.

the consideration of extrinsic evidence, such as conflicting expert testimony, it remains a question of law. *See, e.g., id.; Hormone Research Found. v. Genentech, Inc.*, 904 F.2d 1558, 1562, 1563 n. 7 (Fed.Cir.1990), *cert. dismissed*, 499 U.S. 955, 111 S.Ct. 1434, 113 L.Ed.2d 485 (1991); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579-80 (Fed.Cir.1989); *Tandon Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017, 1021 (Fed.Cir.1987) (citing *H.H. Robertson Co. v. United Steel Deck, Inc.*, 820 F.2d 384, 389 (Fed.Cir.1987); *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1117 n. 11, 1118 (Fed.Cir.1985)). Accordingly, what is the correct definition of "longitudinal axis" is a question of law, and it is within the province of this Court to resolve the issue on summary judgment. *See, e.g., Johnston*, 885 F.2d at 1580 (when the patentee's claims do not read on the accused device exactly, a finding of no literal infringement on summary judgment is proper).

B. *The Infringement Claim Under the Doctrine of Equivalents*

Johnstown asserts that even if the Trinity patent does not literally infringe claims 1 or 6 of the '097 patent, it infringes those claims under the doctrine of equivalents. Under that doctrine, Trinity is liable for infringement if the Aluminator II performs "substantially the same function in substantially the same way to achieve substantially the same result" as the '097 patent. *Malta v. Schulmerich Carillons, Inc.*, 952 F.2d 1320, 1325 (Fed.Cir.1991), *cert. denied*, ___ U.S. ___, 112 S.Ct. 2942, 119 L.Ed.2d 566 (1992). Whether the two are equivalents is a question of fact. *Id.*

Although Trinity acknowledges that equivalency cannot be determined on summary judgment because it is a question of fact, it argues that Johnstown is estopped from pursuing its equivalency claim under the rule known as prosecution history estoppel or "file wrapper estoppel." Prosecution history estoppel "bars a patentee from enforcing its claims against otherwise legally equivalent structures if those structures were excluded by claim limitations added in order to avoid prior art." *Vaupel Textilmaschinen KG v. Meccanica Euro Italia S.P.A.*, 944 F.2d 870, 882 (Fed.Cir.1991) (quotation omitted). Conversely, prosecution history estoppel does not apply when claim language is amended for some reason other than to avoid prior art. Therefore, "[i]n determining whether prosecution history estoppel applies because of a change in claim language during prosecution, the court must consider not only what was changed, but the *reason* for such change." *Id.* As the Federal Circuit has explained,

> Amendment of claims is a common practice in prosecution of patent applications. No reason or warrant exists for limiting application of the doctrine of equivalents to those comparatively few claims allowed exactly as originally filed and never amended. Amendments may be of different types and may serve different functions. Depending on the nature and purpose of an amendment, it may have a limiting effect within a spectrum ranging from great to small to zero.

Hughes Aircraft Co. v. United States, 717 F.2d 1351, 1363 (Fed.Cir.1983).

Whether prosecution history estoppel applies is a question of law. *Hoganas AB v. Dresser Indus.*, 9 F.3d 948, 952 (Fed.Cir.1993). Trinity maintains that prosecution estoppel applies here because Johnstown, in prosecuting its application for the '097 patent, specifically amended the language of claims 1 and 6 to limit those claims to railway cars with troughs whose longitudinal axes are parallel to the longitudinal axis of the center sill.

I am unpersuaded. Although the term "longitudinal axis" was added by amendment, the parallelism requirement was not; claims 1 and 6 in Johnstown's original application described "a pair of concave floor panels, each panel extending parallel to said center sill." Because the parallelism requirement existed even before the claims language was amended, it is beyond dispute that the purpose of amending claims 1 and 6 by adding the term "longitudinal axis" was not to impose parallelism as a "new" limitation on Johnstown's invention.

The parallelism requirement of the Johnstown invention always distinguished it from the Kuehner patent, even before the term "longitudinal axis" was added. Although Trinity correctly notes that the patent examiner rejected Johnstown's application because he determined that the Kuehner patent contained every element of Johnstown's invention, I am not bound by the examiner's decision on that point – particularly as his decision clashes with the language in Johnstown's application. *See, e.g., In re Baxter Travenol Labs*, 952 F.2d 388, 390 (Fed.Cir.1991) (anticipation under 35 U.S.C. § 102 is a question of fact, and a court will reverse a finding of anticipation if clearly erroneous); *see also Axia Inc. v. Jarke Corp.*, 12 U.S.P.Q.2d 1049, 1053, 1989 WL 39722

(N.D.Ill.1989) ("There is . . . support for not applying prosecution history estoppel where a claim is amended in response to an examiner's incorrect rejection.") (citing *Great Northern Corp. v. Davis Core & Pad Co.*, 782 F.2d 159, 166 (Fed.Cir.1986)). It cannot be said that the Kuehner patent, which claimed "[downwardly] inclined trough shaped chute[s] extending longitudinally of the car," anticipated Johnstown's invention, which uses "a pair of concave floor panels, each panel extending parallel to said center sill." Inclined troughs cannot be parallel to a center sill because a sill is, by definition, horizontal. *See Webster's New World Dictionary* 1249 (3d college ed. 1988).

If the purpose of adding the words "longitudinal axis" to claims 1 and 6 was not to distinguish Johnstown's invention from the Kuehner patent, what, then, was its purpose? The only reasonable explanation is that it provided a technical refinement in terminology. The original patent application required that the troughs be parallel to the center sill, whereas the issued patent requires that the longitudinal axes of the troughs be parallel to the longitudinal axis of the sill. The only effect of this change is to specify the two *lines* – rather than the two parts of the car – which must be parallel. It appears that this change was made to simplify and clarify the parallelism requirement. One could anticipate disputes arising under the original language over what *part* of the trough and what *part* of the sill one measures from when determining whether they are parallel. Under the amended language, such disputes are less likely to arise.

Prosecution history estoppel applies where a claim is amended to add a new limitation over prior art, not where, as here, a claim is amended to describe an existing

limitation with more technically precise language. *See, e.g., Andrew Corp. v. Gabriel Elec., Inc.*, 847 F.2d 819, 825 (Fed.Cir.) (prosecution history estoppel did not apply where claim language was amended "for the purposes of explication and clarity"), *cert. denied*, 488 U.S. 927, 109 S.Ct. 312, 102 L.Ed.2d 330 (1988). As no bar exists to Johnstown's infringement claim under the doctrine of equivalents, Johnstown may pursue that claim at trial.

An appropriate order follows.

ORDER

AND NOW, this 2nd day of September, 1994, consistent with the foregoing opinion, defendant's motion for summary judgment (Docket No. 38) is granted in part. It is hereby ORDERED that defendant's motion is GRANTED as to plaintiff's claim for literal infringement, but DENIED as to plaintiff's claim for infringement under the doctrine of equivalents.

This case will be listed on the November 1994 trial term for Johnstown.

EXHIBIT A

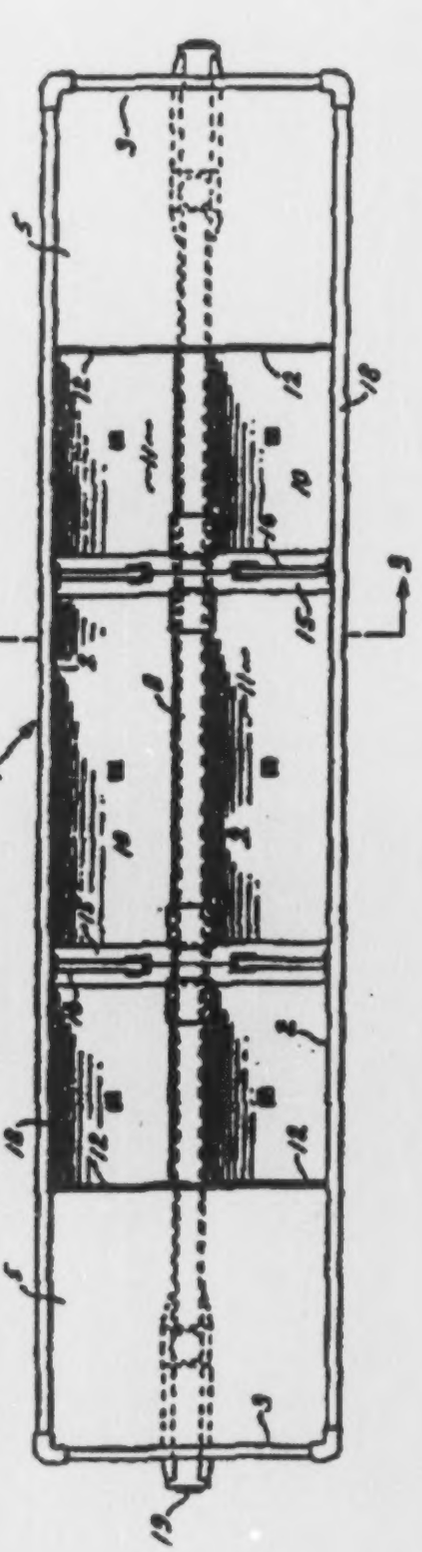

FIG. 2

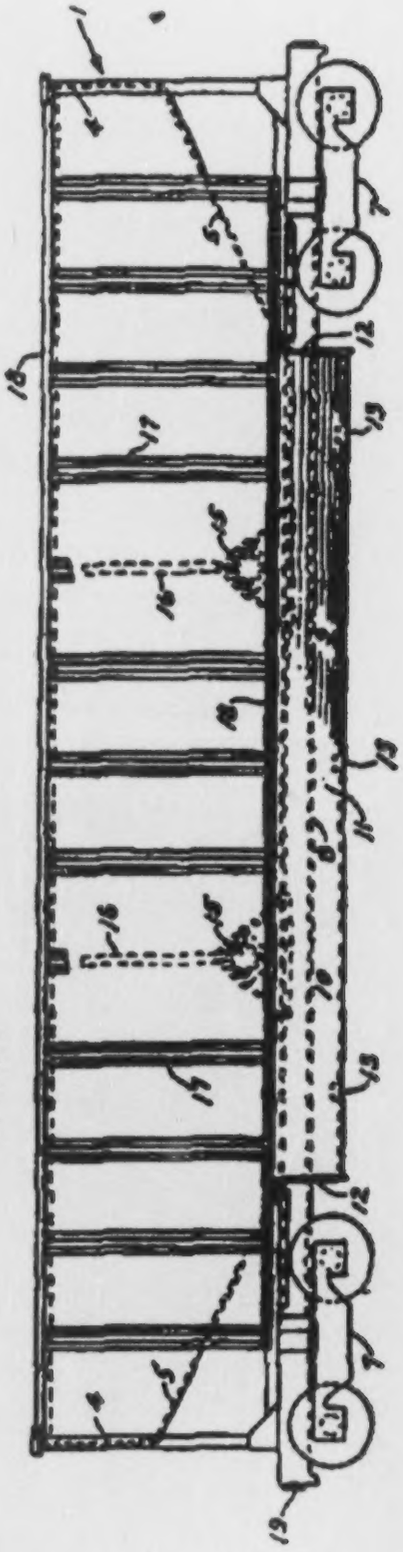

FIG. 1

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EXHIBIT A—Continued

FIG. 3

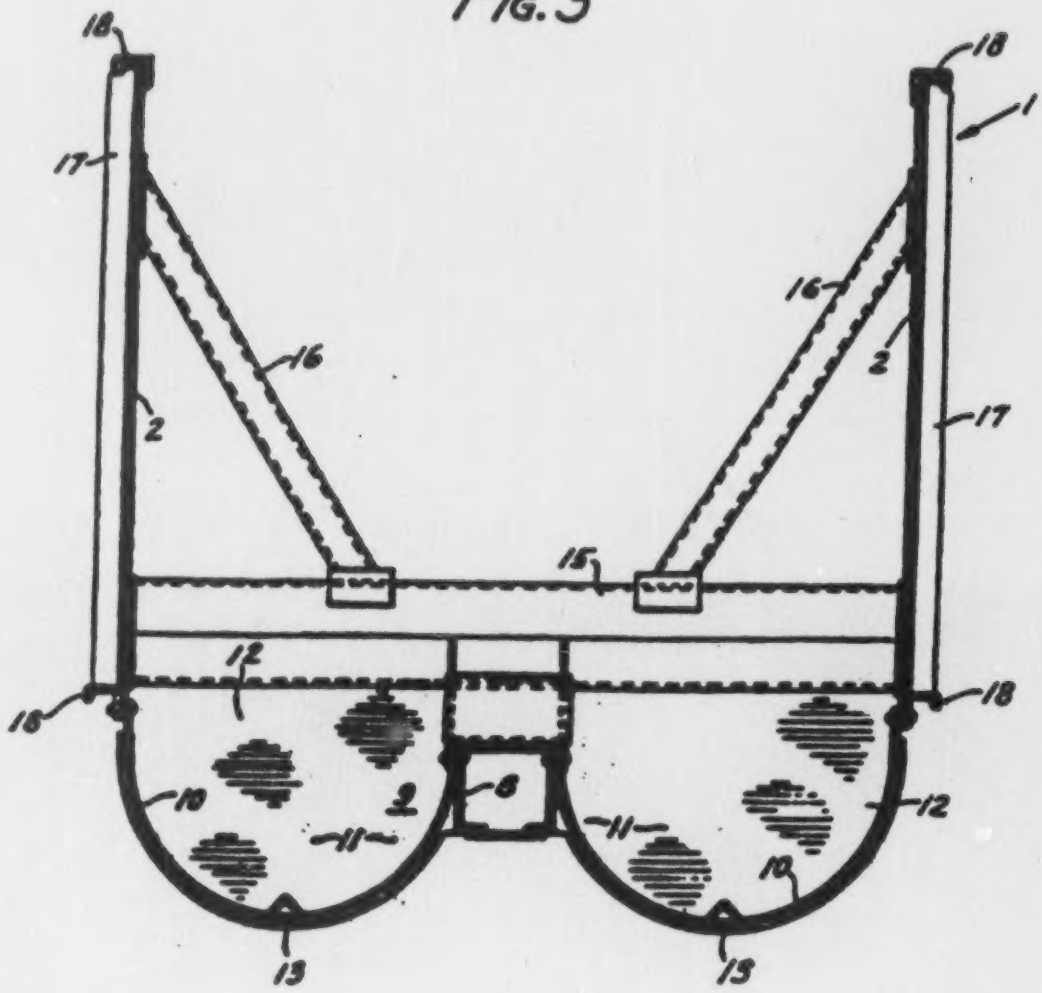
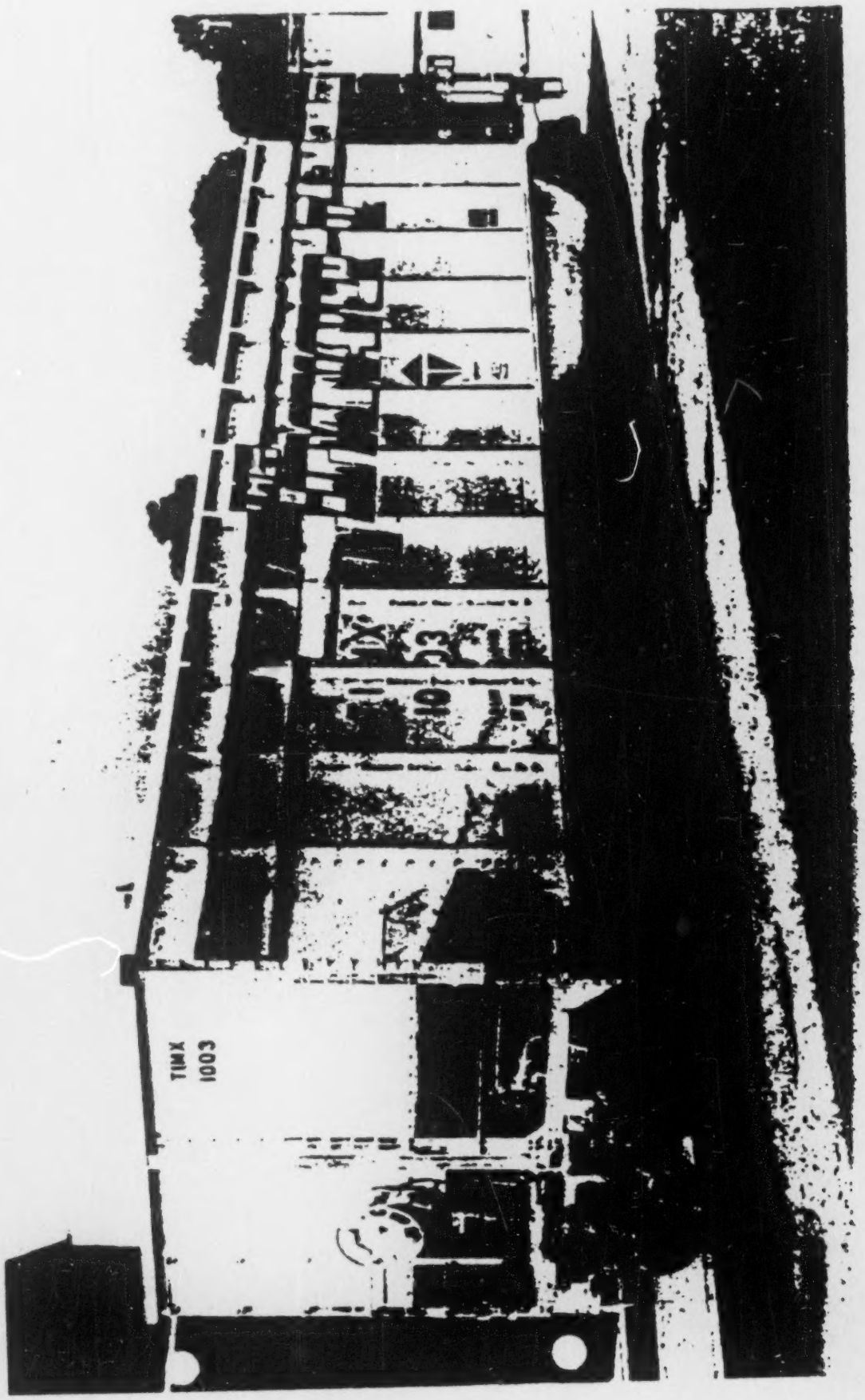


EXHIBIT B



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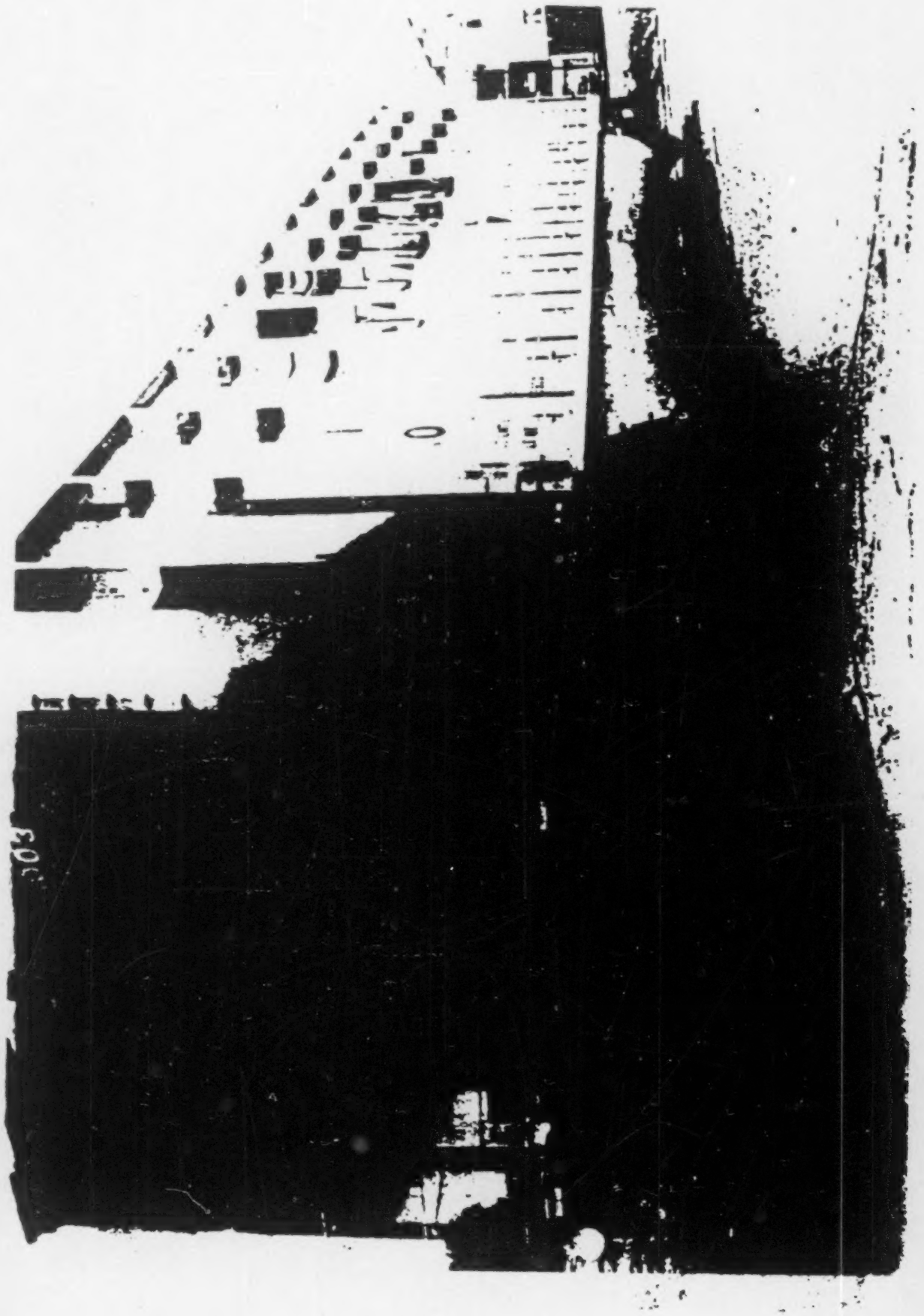

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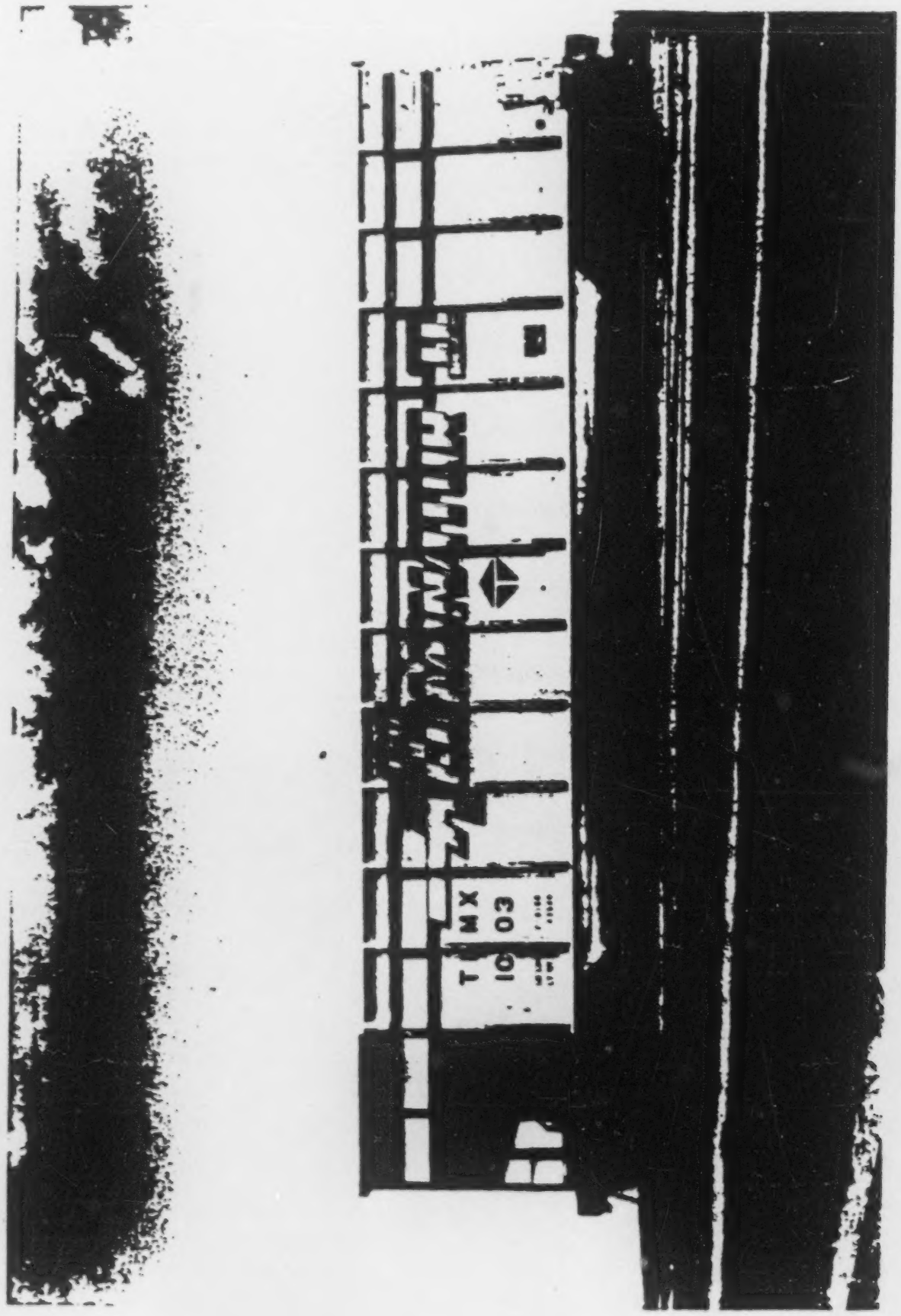


EXHIBIT C

A. T. KUEHNER.

FREIGHT CAR HOPPER.

APPLICATION FILED DEC. 24, 1920.

1,412,660. Patented Apr. 11, 1922.

2 SHEETS—SHEET 1.

Fig. 1.

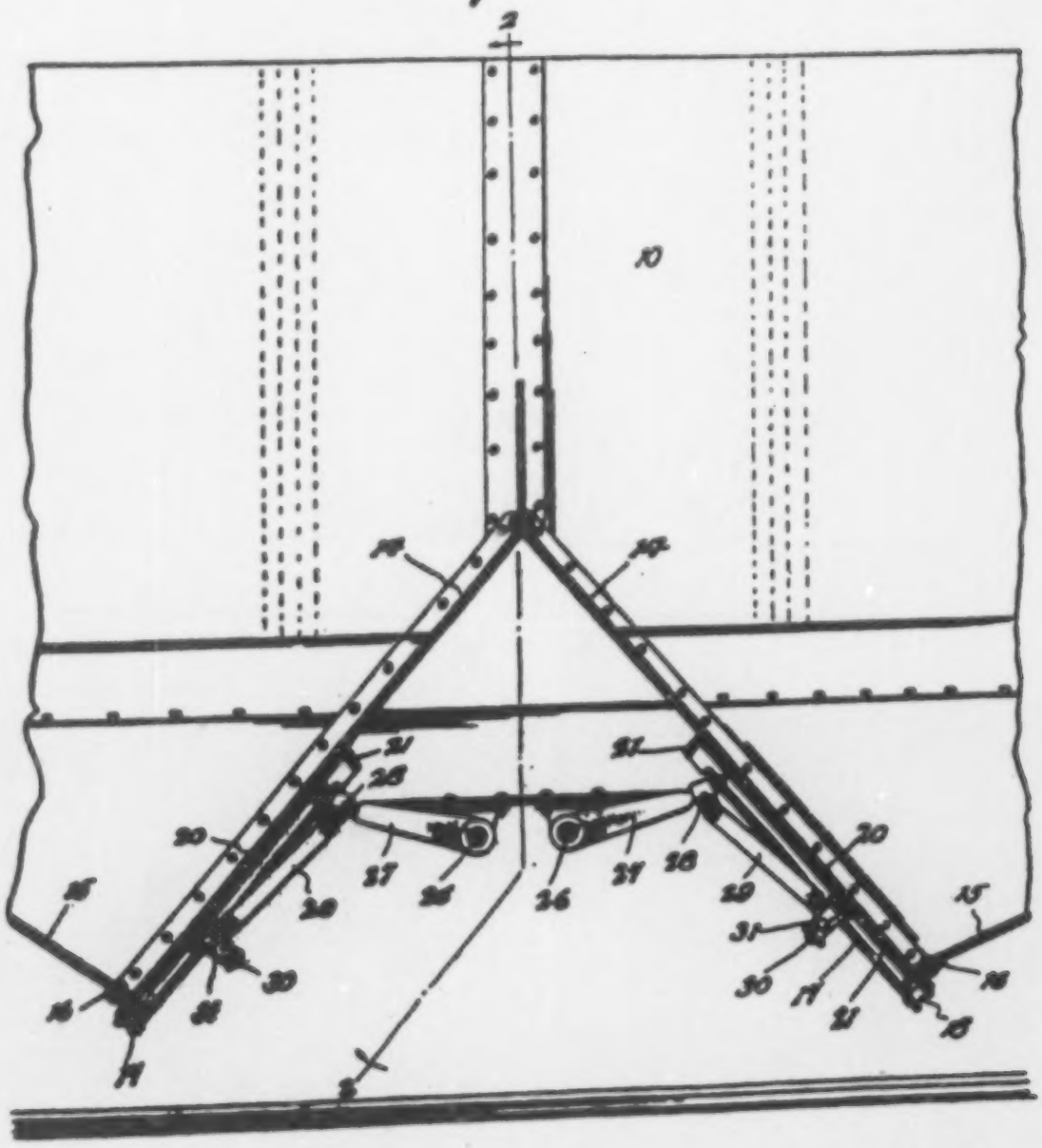


Fig. 4.

Inventor
A. T. Kuehner.

By Lacey & Lacey. Attorneys

App. 31

EXHIBIT C—Continued

A. T. KUEHNER.
FREIGHT CAR HOPPER.
APPLICATION FILED DEC. 24, 1920.

1,412,660. Patented Apr. 11, 1922.
2 SHEETS—SHEET 2.

Fig. 2.

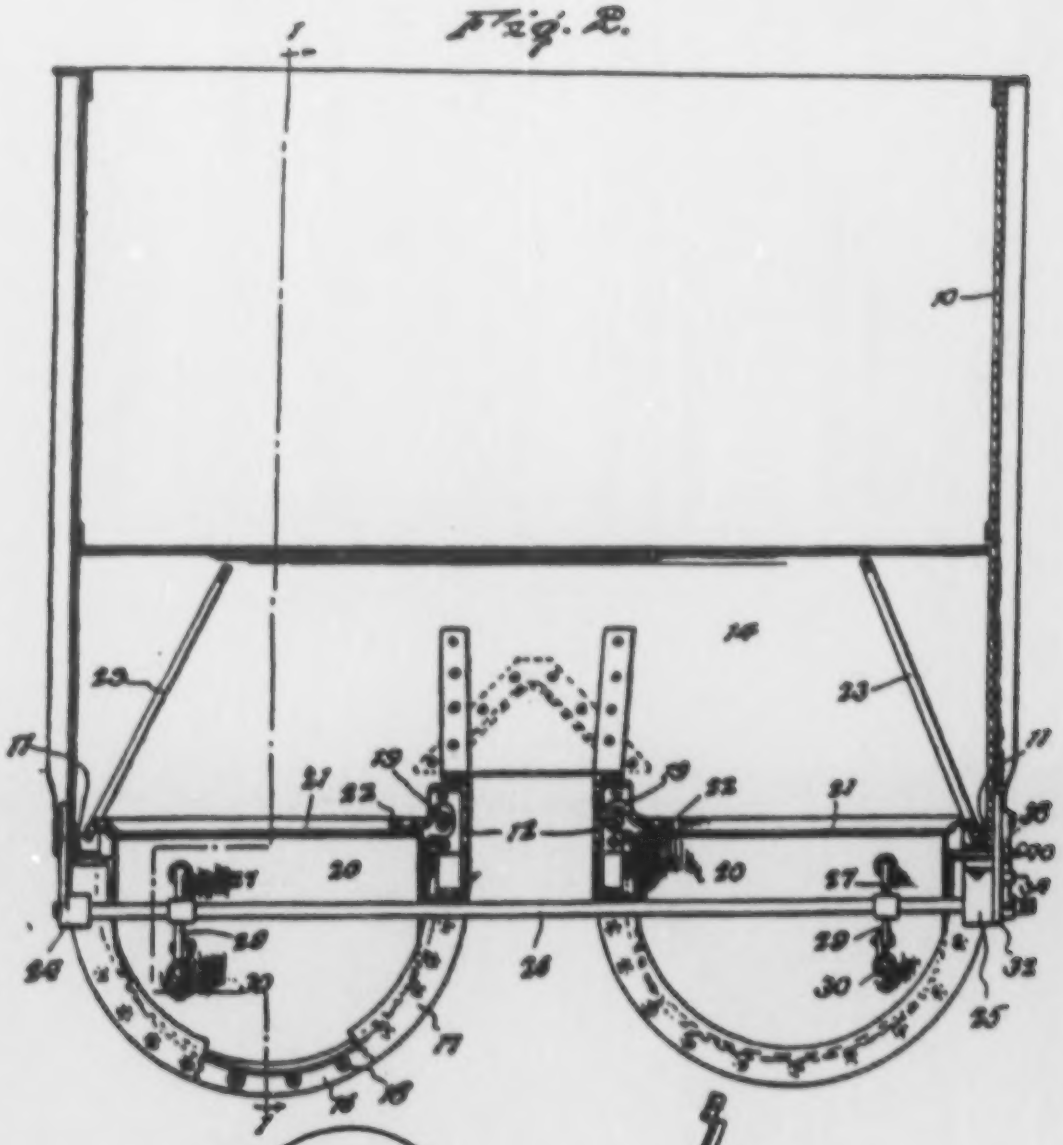


Fig. 3.

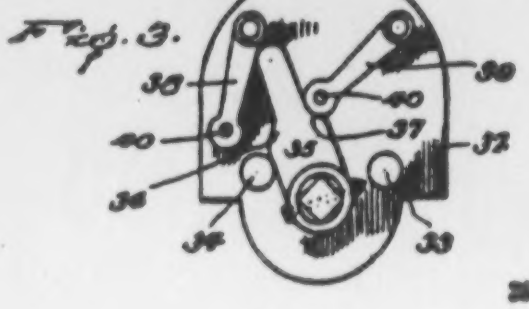
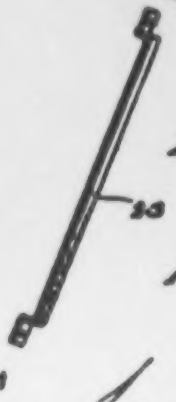


Fig. 5.



Inventor
A. T. Kuehner.

Lacey & Lacey, Attorneys.

UNITED STATES DISTRICT COURT

WESTERN DISTRICT OF PENNSYLVANIA

JOHNSTOWN AMERICA CORPORATION, and JAC PATENT CORPORATION,

Plaintiffs

v.

TRINITY INDUSTRIES, INC.,

Defendant

JUDGMENT IN A CIVIL CASE

CASE NUMBER: Civil Action No. 92-587-J

[X] **Jury Verdict.** This action came before the Court for a trial by jury. The issues have been tried and the jury has rendered its verdict upon answers to special interrogatories.

[ ] **Decision by Court.** This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered.

IT IS ORDERED AND ADJUDGED

That judgment be entered in favor of the defendant, Trinity Industries, Inc.

Judgment is hereby entered in accordance with the above verdict.

8/15/96
Date

/s/ D. Brooks Smith
D. BROOKS SMITH
U.S. District Judge

(By) Deputy Clerk

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

97-1070,-1071

JOHNSTOWN AMERICA CORPORATION
and JAC PATENT CORPORATION,

Plaintiffs-Appellants,

v.

TRINITY INDUSTRIES, INC.,

Defendant-Cross-Appellants.

JUDGMENT

ON APPEAL from the
UNITED STATES DISTRICT COURT FOR
THE WESTERN DISTRICT OF PENNSYLVANIA

in CASE NO(S).
92-CV-587

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED: **REVERSED** and **REMANDED.**

ENTERED BY ORDER OF THE COURT

DATED MAY 28 1997 /s/ Jan Horbaly/KC
Jan Horbaly, Clerk

ISSUED AS A MANDATE: SEP 2 1997

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

97-1070, -1071

JOHNSTOWN AMERICA CORPORATION and JAC PATENT CORPORATION,

Plaintiffs-Appellants,

v.

TRINITY INDUSTRIES, INC.,

Defendant-Appellee.

DECIDED: July 30, 1997

Before ARCHER, *Chief Judge*, CLEVENGER, and SCHALL, *Circuit Judges*. SCHALL, Circuit Judge.

DECISION

Johnstown America Corporation and JAC Patent Corporation (collectively "Johnstown") appealed from the decision of the United States District Court for the Western District of Pennsylvania granting partial summary judgment on the issue of literal infringement in favor of Trinity Industries, Inc. ("Trinity"). *Johnstown Am. Corp. v. Trinity Indus. Inc.*, 865 F. Supp. 1159 (W.D. Pa. 1994). Johnstown also appeals the denial of its motion for judgment as a matter of law, as well as the denial of its motion

to set aside the jury verdict and its motion in the alternative for a new trial. *Johnstown Am. Corp. v. Trinity Indus. Inc.*, No. 92-587J (W.D. Pa. Sept. 13, 1996). On May 28, 1997, in a non-precedential decision, we reversed the judgment of no literal infringement in favor of Trinity and remanded the case to the district court for a determination as to damages and for consideration of Johnstown's argument that Trinity's infringement was willful. *Johnstown Am. Corp. v. Trinity Indus. Inc.*, 114 F.3d 1206 (Fed. Cir. 1996) (unpublished). Trinity now petitions for rehearing. For the reasons stated below, we *deny* Trinity's petition.

DISCUSSION

I.

An extended factual exposition is set forth in our May 28 decision. The facts presented here are limited to those that elucidate the issues related to Trinity's petition for rehearing.

Johnstown sued Trinity for infringement of United States Patent No. 4,361,097 (the '097 patent). *Johnstown*, 865 F. Supp. at 1160. Trinity denied infringement and countered that the patent was invalid. On September 13, 1993, Trinity moved for summary judgment of non-infringement in light of the claim limitation that the longitudinal axes of the troughs extend "parallel to the longitudinal axis of the center sill." *Id.* at 1160-63. Trinity asserted that the limitation was not met literally in its accused railway car, the Aluminator II. *Id.* As far as infringement under the doctrine of equivalents was concerned, Trinity asserted that prosecution history estoppel

barred application of the doctrine to the limitation. *Id.* at 1160. In arguing that summary judgment was proper, Trinity asserted: "There are no fact issues concerning the physical structure of the Aluminator II railway car: it is what it is, as documented by the exhibits to the Affidavit of Mr. Minshull." Johnstown submitted an untimely motion for summary judgment of infringement, which the district court declined to consider.

On September 2, 1994, the district court granted summary judgment in favor of Trinity on the issue of literal infringement, but denied it with respect to infringement under the doctrine of equivalents. *Johnstown*, 865 F. Supp. at 1160. With regard to infringement under the doctrine of equivalents, the district court rejected Trinity's prosecution history estoppel argument and concluded that there were material issues of fact for the jury to decide. *Id.* at 1165-66. Following trial, the jury found no infringement under the doctrine of equivalents. The jury also found the '097 patent not invalid. Johnstown's appeal followed.

II.

In its petition for rehearing, Trinity focuses on both infringement and validity, although it chooses not to challenge our construction of the parallelism limitation of claims 1 and 6. As far as infringement is concerned, Trinity contends that its Aluminator II does not meet the "curvilinear" and "pair of trough" limitations of claims 1 and 6. Trinity states that, in order to escape literal infringement, it only had to prevail on summary judgment with respect to one of the limitations of the claims

and that it sought summary judgment based upon the parallelism limitation. Trinity asserts that, having found that the "parallel axes" limitation reads on the accused device, we should have remanded for a determination as to whether "curvilinear" and "pair of trough" limitations do so as well. In opposition to Trinity's petition, Johnstown argues that "[t]he factual conclusion that the [Aluminator II] car has a pair of troughs that are curvilinear is indisputable and a retrial would be futile."

As a general proposition, Trinity is correct that when an accused infringer moves for summary judgment of noninfringement based upon a particular claim limitation, it does not, in so doing, give up the argument that there is no infringement because other limitations are not met. *Cf. Hi-Life Prods., Inc. v. American Nat'l Water-Mattress Corp.*, 842 F.2d 323, 325, 6 USPQ2d 1132, 1133 (Fed. Cir. 1988) ("Literal infringement requires that the accused [devices] embody every limitation of the asserted claims."). However, that the infringement issue is not foreclosed by our finding that the district court erred in granting summary judgment does not necessarily preclude us from now completing the infringement analysis on appeal. As stated in *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), we reverse rather than remand when "[n]othing of record warrants a further exercise of the [trial court's] fact-finding function or indicates any possibility that the appealed judgment might be sustained by such exercise." *Id.* at 1565-66; 1 USPQ2d at 1595.

We stated in our May 28 decision that, in the district court, "[i]t was undisputed that the other limitations of claims 1 and 6 were met in the Aluminator II." Although

the matter is not entirely clear from the record before us, we will accept for purposes of the petition for rehearing Trinity's statement that it "vigorously disputed" whether the "curvilinear" and "pair of trough" limitations were present in the Aluminator II. Significantly, though, Trinity itself acknowledges that the structure of the Aluminator II is not in dispute. Indeed, Trinity takes the position in its petition that we should affirm the district court's grant of summary judgment because the "curvilinear" and "pair of trough" limitations are missing from the Aluminator II. Thus, there are "no evidentiary conflicts requiring resolution on the issue of infringement." *See Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1539, 19 USPQ2d 1367, 1372 (1991). After comparing the accused device with claims 1 and 6, we conclude that the "curvilinear" and "pair of trough" limitations are both met in the Aluminator II. Accordingly, we remain of the view that the district court's judgment of no literal infringement must be reversed.

Turning to validity, Trinity asserts that the issue was tried based upon the district court's construction of the parallelism limitation – a construction that we specifically rejected. Trinity also asserts that "there was . . . no apparent reason for Trinity to appeal the jury's finding that the '097 patent was not invalid because judgment was entered in Trinity's favor." Trinity urges that considerations of fairness require that we now remand for a determination of whether the claims, as properly construed, are valid. In response, Johnstown asserts that, in the district court, the parallelism limitation was irrelevant to Trinity's case and that, in any event, Trinity has waived the validity issue by not appealing it. We conclude that,

by failing to specifically appeal the finding of validity, Trinity has waived the issue.

Each party shall bear its own costs.